

**REMARKS**

Claims 32-38 and 43-47 are pending in this application, of which Applicants amend claims 32, 34, 43, and 45.

**Claim Amendments**

Applicants amend claims 32, 34, 43, and 45 to more appropriately define the claimed subject matter and for the sake of consistency. These amendments do not add any new subject matter.

**103(a) Rejection of Claims 32-35 and 43-46**

The Examiner rejected claims 32-35 and 43-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,768,164 to Hollon, Jr. ("*Hollon*") in view of U.S. Patent No. 6,633,930 to Sonehara et al. ("*Sonehara et al.*"). Applicant respectfully traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness under §103(a), each of three requirements must be met. "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," to combine references or modify a reference. MPEP § 2143 (8th ed. Rev. Feb. 2003). Second, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. *Id.* Moreover, both of these requirements must "be found in the prior art, not in applicant's disclosure." *Id.* Third, the reference or references, taken alone or in combination, must disclose or suggest every element recited in the claims. *Id.*

Claims 32-35 and 43-46

Applicant respectfully traverses the Examiner's rejection of claims 32-35 and 43-46, as unpatentable over *Hollon* in view of *Sonehara et al.*, at least because these references, alone or in combination, fail to teach or suggest each and every element of independent claim 32, from which claims 33-35 depend, and these references also fail to teach or suggest each and every element of independent claim 43, from which claims 44-46 depend. For example, *Hollon* fails to teach or suggest a "main display," a "sub-display provided ... at a position where the sub-display is externally visible when the main display is in a closed position," and either

**"a jog device which starts an application program in one of a power-off state, a sleeping state, and a main display off state" and "display control means which displays, in the power-off state, sleeping state, or main display off state, a name of the application program to be started,"** as recited in amended claim 32 (emphasis added); or

**"detecting an event generated by the jog device to start an application program in one of a power-off state, a sleeping state, and a main display off state" and "displaying, in the power-off state, sleeping state, or main display off state, a name of the application program to be started,"** as recited in amended claim 43 (emphasis added).

The Examiner relies on *Hollon* to disclose "display control means which displays an application program to be started in response to the event generated by a control device on the sub-display in one of a power-off state, a sleeping state, and a main display off state" (Office Action, pg. 2, paragraph 5). However, *Hollon* does not teach a "jog device" for "start[ing] an application program in one of a power-off state, a sleeping state, and a main display off state" or "display[ing], in the power-off state, sleeping state, or main display off state, a name of the application program to be started," as required by independent claims 32 and 43.

Instead, *Hollon* teaches that “[w]hen a user of portable computer 10 desires to utilize a particular application program on spontaneous use display 39, the user locates the active window of the application program at section 21 of display 20 (shown in FIG. 1). The user then puts portable computer 10 into an inactive mode and closes the cover.” (Col. 2, line 65 to col. 3, line 3; emphasis added.) “Spontaneous use function keys 31 through 38 are respectively mapped to the functionality of function keys 11 through 18” (Col. 2, lines 62-64).

The “spontaneous use function keys 31 through 38” do not constitute a “jog device” for “start[ing] an application program in one of a power-off state, a sleeping state, and a main display off state,” as would be required by each of independent claims 32 and 43. The “spontaneous use display 39” also does not display, “in the power-off state, sleeping state or main display off state, a name of the application program to be started” by the jog device. Rather, the “application program” of *Hollon* must already have been started in an “active window” before the application program can be utilized on “spontaneous use display 39.”

*Sonehara et al.* does not make up for the deficiencies of *Hollon* because *Sonehara et al.* only discloses a jog device and its associated hardware and software. *Sonehara et al.* also fails to teach a “jog device” for “start[ing] an application program in one of a power-off state, a sleeping state, and a main display off state” or “display[ing], in the power-off state, sleeping state, or main display off state, a name of the application program to be started,” as recited in claims 32 and 43.

In response to Applicant's arguments, the Examiner asserts that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references," citing *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). (Office Action, pg. 5, paragraph 5.) However, the cited sections of *In re Keller* and *In re Merck & Co.* refer to rebutting a case of *prima facie* obviousness that has already been established. In the present case, Applicant has explained the reasons that the Examiner has failed to establish a *prima facie* case of obviousness. Thus, Applicant's arguments are proper in view of the holdings of these cases.

For example, there is no *prima facie* case of obviousness for at least the reason that *Hollon* and *Sonehara et al.*, taken in combination, do not disclose or suggest each and every element recited in the claims. MPEP § 2143 (8th ed. Rev. Feb. 2003). As explained above, neither of the references teaches or suggests the element of "a jog device which **starts an application program in one of a power-off state, a sleeping state, and a main display off state**" or the element of "display control means which displays, **in the power-off state, sleeping state, or main display off state, a name of the application program to be started,**" as recited in claim 32 (emphasis added). Furthermore, neither of the references teaches or suggests the element of "detecting an event generated by the jog device **to start an application program in one of a power-off state, a sleeping state, and a main display off state**" or the element of "displaying, **in the power-off state, sleeping state, or main display off state, a name of the application program to be started,**" as recited in claim 43 (emphasis added). Thus, the Examiner has not established a *prima facie* case of obviousness.

Thus, since *Hollon* and *Sonehara et al.*, taken alone or in combination, do not teach or suggest each and every element of independent claim 32 or independent claim 43, claims 32 and 43, and claims 33-35 and 44-46 dependent therefrom, respectively, are allowable over *Hollon* and *Sonehara et al.*

### **103(a) Rejection of Claims 36-38 and 47**

The Examiner also rejected claims 36-38 and 47 under 35 U.S.C. § 103(a) as unpatentable over *Hollon*, *Sonehara et al.*, and *Mondshine et al.* Applicant respectfully traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

#### **Claims 36-38**

Claims 36-38 are allowable over *Hollon*, *Sonehara et al.*, and *Mondshine et al.* at least because these claims depend from claim 32, which is allowable over *Hollon* and *Sonehara et al.* for at least the reasons explained above.

*Mondshine et al.* fails to make up for the deficiencies of *Hollon* and *Sonehara et al.* because *Mondshine et al.* also does not teach or suggest the elements of “a jog device which **starts an application program in one of a power-off state, a sleeping state, and a main display off state**” or “display control means which displays, **in the power-off state, sleeping state, or main display off state, a name of the application program to be started,**” as recited in claim 32 (emphasis added).

#### **Claim 47**

Claim 47 is allowable over *Hollon*, *Sonehara et al.*, and *Mondshine et al.* at least because this claim depends from claim 43, which is allowable over *Hollon* and

*Sonehara et al.* for at least the reasons explained above in reference to the rejection of claim 43.

*Mondshine et al.* does not make up for the deficiencies of *Hollon* and *Sonehara et al.* because *Mondshine et al.* also fails to teach or suggest the elements of “detecting an event generated by the jog device **to start an application program in one of a power-off state, a sleeping state, and a main display off state**” and “displaying, in the power-off state, sleeping state, or main display off state, a name of the application program to be started,” as recited in claim 43 (emphasis added).

#### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_



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